

## REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed March 6, 2003. Reconsideration and allowance of the application and pending claims are respectfully requested.

### **I. Claim Rejections - 35 U.S.C. § 112, Second Paragraph**

Claims 1-29 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. In particular, the Examiner states that "it is not seen how matches can be determined if only fragment instead of the entire address/number is compared with a stored one."

In response to the rejection, the claims have been amended to replace the term "fragment" of an "address/number" with "sending information". Applicants note that the term "fragment" was originally used in the claims to cover the situation in which only a part of the sending information is entered, but a match is determined prior to completion of the information. For example, if the user entered the address fragment "john@xy", and the address "john@xyz123.com" is stored in memory, a match may be identified prior to completion of the address. In such a case, an autocomplete function, such as that commonly used in contacts programs, of the sending device may provide the remaining characters of the address, in which case the user would not literally "enter" the entire address. Regardless, the term "sending information" is deemed broad enough to encompass both whole and incomplete addresses or numbers, and further removes any ambiguity that the "fraction" terminology may have created.

In addition to the above-noted rejection, claim 6 and other claims have been rejected as being confusing. Applicants believe that the amendments of this Response remove any such confusion.

Finally, claim 8 and other claims have been rejected because it is alleged that the term "distribution list" is unclear. On this point, Applicants respectfully assert that distribution lists are well known to persons having ordinary skill in the electronic mail and computing arts generally.

In view of the above, it is respectfully asserted that claims 1 and 4-24 that remain under consideration currently define the invention in the manner required by 35 U.S.C. § 112. Accordingly, it is respectfully requested that the rejections to these claims be withdrawn.

## **II. Claim Rejections - 35 U.S.C. § 103(a)**

### **A. Statement of the Rejection**

Claims 1-29 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Paul (U.S. Pat. No. 5,999,932).

The rejection alleges that Paul discloses Applicants' invention substantially as claimed with the exception of the idea of automatically updating a database using sending information contained in outgoing messages (which arguably is the crux of the invention). The rejection concludes, however, that it would have been obvious to a person having ordinary skill in the art to so modify the Paul system and method. Applicants respectfully traverse this rejection.

## **B. Applicants' Claimed Invention**

Applicants' claims describe systems and methods through which sending information, such as email addresses and fax numbers, may be automatically stored in a user contacts database if they are not already contained in the database through virtue of the user entering the sending information. As provided in Applicants' amended claim 1, for example, Applicants claim:

1. A method for processing sending information in a sending device, comprising:

*receiving an entry input by a user into the sending device, the entry comprising sending information that identifies a destination to which information is to be sent by the sending device;*

*cross-referencing the user-entered sending information with a contacts database that contains recipient sending information of the user to determine if the user-entered sending information matches sending information saved in the contacts database; and*

*automatically caching the user-entered sending information in the contacts database if the user-entered sending information has not been previously saved.*

Applicants' claim 1 (emphasis added).

## **C. The Paul Reference**

In stark contrast to Applicants' claimed inventions, Paul discloses a system for *filtering unsolicited electronic mail messages*. As described in the Abstract of the Paul reference, Paul's system operates by first attempting to match identification data with a "user inclusion list." If the identification data matches, the email is marked "OK." If the data does not match, the system performs a "heuristic process" to determine whether the

message may be "of interest" to the user. If certain criteria are met, the message is marked as "NEW." If, on the other hand, the criteria are not met, the message is marked as "JUNK."

#### **D. Discussion of the Rejection**

As noted above, several amendments have been made to the claims to remove any ambiguity that may have been created by their original form. Due to these amendments, the rejection is believed to be moot as being directed toward the claims in their original form. However, to facilitate the Examiner's understanding of the differences between Applicants' claimed inventions and Paul's system, Applicants provide a brief discussion of the merits of the rejection.

As acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a proper case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See In re Fine, 837, F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Accordingly, to make a proper case for obviousness, there must be some prior art teaching or established knowledge that would suggest to a person having ordinary skill in the pertinent art to fill the voids apparent in the applied reference. It is respectfully asserted that no such case has been made in the outstanding Office Action.

As described above, Paul's system is directed to *filtering unsolicited electronic mail messages*. As a result, the Paul disclosure fails to anticipate or render obvious several limitations of Applicants' claims that, as noted above, pertain to automatically storing sending information, such as email addresses and fax numbers, in a database

through virtue of the user entering the sending information. Accordingly, with reference to independent claim 1, for example, Paul fails to disclose “receiving an entry *input by a user into the sending device*” (emphasis added). In addition, Paul fails to disclose entering sending information that “identifies a destination *to which information is to be sent by the sending device*” (emphasis added). Moreover, Paul fails to disclose “cross-referencing the user-entered sending information *with a contacts database*” (emphasis added). Furthermore, Paul fails to disclose “*automatically caching the user-entered sending information in the contacts database* if the user-entered sending information has not been previously saved” (emphasis added).

Although it is asserted in the Office Action that it would have been obvious to use Paul’s teachings for “updating addresses of incoming messages,” Applicants respectfully submit that, irrespective of the veracity or falsity of that statement, “updating addresses of incoming message” is not what Applicants’ inventions do and that is not what is recited in Applicants’ claims. As a further point, Applicants respectfully note that the cited “reason” for the alleged obviousness is merely a conclusion and not a reason at all. Therefore, it is respectfully asserted that the stated basis for obviousness is not proper.

In summary, it is Applicants’ position that Paul neither anticipates nor renders obvious Applicants’ remaining independent claims 1, 9, 15, or 20, or the claims which depend therefrom. Therefore, it is respectfully submitted that each of these claims is patentable over Paul and that the rejection of these claims should be withdrawn.

### **III. Canceled Claims**

As identified above, claims 2-3 and 25-29 have been canceled from the application through this Response without prejudice, waiver, or disclaimer. Applicants

reserve the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

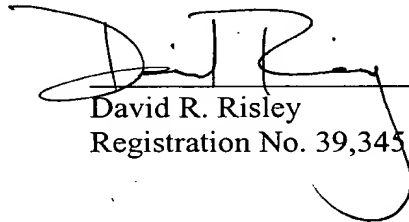
#### **IV. Newly Added Claims**

As identified above, claim 30 has been added into the application through this Response. Applicants respectfully submit that this new claim describes an invention novel and unobvious in view of the prior art of record and, therefore, respectfully requests that claim 30 be held to be allowable.

### CONCLUSION

In light of the foregoing, Applicants respectfully submit that claims 1, 4-24, and 30 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

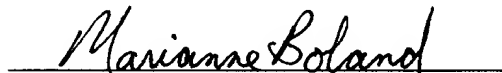
Respectfully submitted,



David R. Risley  
Registration No. 39,345

**THOMAS, KAYDEN,  
HORSTEMEYER & RISLEY, L.L.P.**  
Suite 1750  
100 Galleria Parkway N.W.  
Atlanta, Georgia 30339  
(770) 933-9500

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Washington D.C. 20231, on 5-15-03.



Signature

**ANNOTATED VERSION OF MODIFIED CLAIMS**  
**TO SHOW CHANGES MADE**

The following claims have been amended by deleting the bracketed (“[ ]”) portions and adding the underlined (“  ”) portions.

1. (Once amended) A method for processing sending information in a sending device, comprising:

receiving an entry input by a user into the sending device, the entry comprising [at least a fragment of] sending information that identifies a destination [address/number] to which information is to be sent by the sending device;

cross-referencing the [address/number] user-entered sending information [fragment] with a contacts database [assigned to] that contains recipient sending information of the user to determine if the [address/number] user-entered sending information matches [an address/number] sending information saved [for that user] in the contacts database; and

automatically caching the [address/number] user-entered sending information in the [user's] contacts database if the [address/number] user-entered sending information has not been previously saved.

4. (Once amended) The method of claim 1, wherein the [user] contacts database is stored within sending device memory.

5. (Once amended) The method of claim 1, further comprising providing [a] previously saved [address/number] sending information to the user if it matches [the address/number] sending information [fragment] entered by the user.



6. (Once amended) The method of claim 5, wherein the previously saved [address/number] sending information was automatically cached by the device.

7. (Once amended) The method of claim 1, wherein the sending device is a digital sender capable of e[-]mailing and faxing hardcopy documents.

9. (Once amended) A method for processing sending information in a sending device, comprising:

[authorizing a user to access the sending device] receiving an entry by a user with the sending device and determining the identity of the user from the entry;

[providing the user with a list of previously saved destination addresses/numbers which have been saved for that user;]

receiving [at least a fragment of] sending information entered by the user that identifies a destination [address/number input by the user] to which information is to be sent by the sending device;

cross-referencing the [address/number] sending information [fragment] entered by the user with a contacts database [assigned to] that contains recipient sending information of the user to determine if the [address/number] user-entered sending information matches [an address/number] sending information saved for that user;

providing [a] previously saved [address/number] sending information to the user as a selection option if [it matches the address/number] sending information [fragment] entered by the user matches the previously saved sending information; and

automatically caching the [address/number] user-entered sending information in the [user's] contacts database if [it] the user-entered sending information has not been previously saved.

10. (Once amended) The method of claim 9, wherein [authorization is obtained by logging in] receiving an entry by a user with the sending device comprises receiving log in information.

11. (Once amended) The method of claim 9, wherein the [user] contacts database is stored within sending device memory.

12. (Once amended) The method of claim 9, wherein the previously saved [address/number] sending information was automatically cached by the device.

15. (Once amended) A sending information processing system, comprising:

logic configured to receive [at least a fragment of] sending information entered by a user that identifies a destination [address/number] to which electrical information is to be sent;

logic configured to cross-reference the [address/number fragment] user-entered sending information with a contacts database [assigned to] that contains recipient sending information of the user to determine if the [address/number] user-entered sending information matches [an address/number] sending information saved for that user in the database; and

logic configured to automatically cache the [address/number] user-entered sending information in the [user's] contacts database if [it] the user-entered sending information has not been previously saved.

16. (Once amended) The system of claim 15, further comprising logic configured to provide [a] previously saved [address/number] sending information to the user if it matches [the address/number fragment entered by the user] user-entered sending information.

17. (Once amended) The system of claim 16, wherein the previously saved [address/number] sending information is obtained from the [user] contacts database.

20. (Once amended) A sending information processing system, comprising:

means for receiving through entry by a user [at least a fragment of] sending information that indicates a destination [address/number] to which information is to be sent;

means for cross-referencing the [address/number fragment] user-entered sending information with a contacts database [assigned to] that contains recipient sending information of the user to determine if the [address/number] user-entered sending information matches [an address/number] sending information saved in the database for that user; and

means for automatically caching the [address/number] user-entered sending information in the [user's] contacts database if [it] the user-entered sending information has not been previously saved.

21. (Once amended) The system of claim 20, further comprising means for providing [a] previously saved [address/number] sending information to the user if it matches [the address/number fragment] sending information entered by the user.

22. (Once amended) The system of claim 21, wherein the previously saved [address/number] sending information is obtained from the [user] contacts database.